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Supreme Court of the United States

OCTOBER TERM, 1963

No. 602

MINNESOTA MINING AND MANUFACTURING COMPANY,

Petitioner,

v.

THE PLYMOUTH RUBBER CO., INC.,

Respondent.

BRIEF FOR THE RESPONDENT IN OPPOSITION

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BRIEF FOR THE RESPONDENT IN OPPOSITION

Opinions Below

The opinion of the District Court is reported at 203 F. Supp. 595. The opinion of the Court of Appeals is reported at 321 F. 2d 151.

Jurisdiction

The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

Questions Presented

1. Was the finding of fact that respondent's product "is made in the same way and from the same materials" as respondent's product earlier held not to infringe petitioner's patent, in a first judgment binding on both parties, clearly erroneous?

2. Was the finding of fact that respondent's product contains no "liquid" plasticizer (absence of which was held

to establish non-infringement, in resolution of the basic question actually litigated and determined, by the first judgment and essentially to it) clearly erroneous?

3. Is not the product's freedom from infringement res judicata, not only because of the above facts and first judgment, but additionally because of further judgments binding on the parties which determined, essentially to each and in each an actually litigated question, that the admittedly same product did not infringe?

Rule Involved

F. R. Civ. P. 52:

"Findings by the Court.

"a. Effect. * * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *"

Statement

There are no "special and important reasons" for review on writ of certiorari of the "question presented" by petitioner (Pet. 2). Material facts not set forth by petitioner reveal furthermore not only that the asserted question is hypothetical, but that it would not in any event be dispositive.

As petitioner states (Pet. 3), the patent in suit is concerned with prescribing for use in vinyl plastic a plasticizer of such a nature that it makes the vinyl stretchy enough for adhesive electrical tape without hurting the adhesive.

It had earlier been recognized that a "stretchable and retractable" (like the old rubber tape used for the purpose)

vinyl electrical adhesive tape would be a desirable product (R. 405). However, it had been found that when enough "liquid plasticizer" was used to make the vinyl plastic adequately stretchy, some of it migrated into the adhesive, spoiling it by making it go "pasty" (id.).

In 1943, Rohm & Haas, "a widely known chemical company of Philadelphia, produced a new type of high-molecular-weight resinous plasticizer known as 'Paraplex G-25', which could be combined satisfactorily with vinyl without causing migration." (R. 416, 31). The first production batch of G-25 was in 1944 (R. 32). Using it, petitioner came on the market with its commercial electrical tape in 1945, and filed its patent application in 1946 (R. 416). There is no evidence that any commercial insulating tape has ever been marketed that has not used as a non-migrating plasticizer either G-25 or one which appeared on the market even later.

When the new G-25 was first tried as the sole plasticizer by petitioner, it was found that, far from migrating into the adhesive and making it "pasty", it in time resulted in the adhesive's losing "initial tackiness or pressure-sensitivity" (R. 406). The patentees' "problem" was thus how to achieve "permanent equilibrium", by which they meant "that the . . . /adhesive layer neither softens (becomes 'pasty') [as with liquid plasticizers] nor loses tackiness (becomes non-adherent) [as with resinous plasticizers] on prolonged contact with the backing" (R. 406). Their solution was to use some of each type of plasticizer.

The patent summarizes its teaching thus (R. 406, col. 3, line 21):

> "In order to secure permanent equilibrium between backing and adhesive, we employ with the vinyl chloride polymer a combination of modifiers including a substantial but minor amount (not to exceed about 20 parts per 100 parts of the vinyl

> polymer) of a low molecular weight *liquid plasticizer*, such as dioctyl phthalate, together with a substantially equal or somewhat greater amount of a high molecular weight *resinous type plasticizer*, the amount of the latter in any event being sufficient, together with the liquid plasticizer, to provide the desired degree of stretch in the final film."*

After the Patent Office had twice rejected as unpatentable over prior patents, and as improperly indefinite or functional, originally filed claims specifying plasticizer content much as in the language just quoted (R. 543, 547-8, 558), these claims were canceled and replaced by a narrower one that became (after slight further amendment) the broadest of the original patent (R. 560), and required "a liquid phthalyl ester plasticizer amounting to 8 to 20 parts per 100 parts of [the vinyl] polymer, and a soft and viscous alkyd resin plasticizer". With this same amendment was included these remarks about the cited prior art (R. 566):

> "There is no suggestion of the three-way blend used by applicants, employing the vinyl chloride polymer, the liquid phthalyl ester, and the alkyd resin, *combined together*. That this three-way blend is essential to the success of applicants' product was clearly pointed out in the application as filed." (Emphasis Petitioner's.)

Nevertheless, after respondent (hereinafter sometimes called "Plymouth") had succeeded in formulating and marketing a product in which only resinous plasticizer was used (R. 417), petitioner (hereinafter sometimes called "Minnesota") sought and obtained by reissue (R. 405) claims (numbered 6 through 9, and printed in italics, R. 409-10) in which the plasticizer was defined simply as

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*Emphasis ours throughout this brief unless otherwise noted.

"comprising at least a major proportion of a non-migrating viscous plasticizer resin". This definition purported to be broader even than that of the original claims canceled following rejection; and so broad as to make non-essential the liquid plasticizer taught in the original specification (R. 406), and urged during prosecution (supra 4), to be essential.

Armed with its reissue, Minnesota launched a series of attacks on Plymouth's tapes, against Plymouth and its customers.

Sears, Roebuck & Co. v. *Minnesota Mining & Mfg. Co.*, 243 F. 2d 136 (4 Cir. 1957), on petition for rehearing and motion to reopen 249 F. 2d 66, cert. den'd 355 U. S. 932, reh. den'd 356 U. S. 915, in which Plymouth controlled the defense of its customer Sears, produced the first judgment binding on these parties. In reversing the District Court (Hayes, D. J.), the Court of Appeals, which had before it an extensive record including much testimony by chemist expert witnesses, ruled that there could indeed be no infringement without use of a "liquid" plasticizer. In rejecting Minnesota's argument that the lower molecular weight fractions of the resinous plasticizer were really liquid (243 F. 2d 136, 143-4; R. 424, 425), the Court said:

> "*The evidence clearly shows that there are two well defined and distinctive types of plasticizers*, as the language of the specification indicates, which are not only *well recognized by the trade* but are characterized by substantial differences in chemical composition. The *liquid plasticizers* are *all monomeric* that is, they are simple, precise and well defined chemical compounds of low-molecular-weight ranging from 250 to 600. In them every molecule is like every other molecule so that the material *cannot be fractionated*. It is thinly fluid. DOP for example has a molecular weight of 390 and a viscosity of less than one poise, which is the unit by which vis-

> cosities are measured. *Resinous plasticizers on the other hand are polymeric.* They are synthetic compositions made by combining chemicals of high-molecular-weight and are extremely viscous. G-25, for example, has a viscosity of 1000 poises. The *molecules of these resins are combinations of varying numbers of so-called building units* and accordingly vary in weight, ranging in the case of G-25 from 1000 to 50,000. Its average molecular weight is 8000. *It is substantially correct to say that no part of G-25 is liquid and no part of DOP is resinous, as these terms are known to the art.*
>
> * * *
>
> *"Even if it be supposed that the composition of G-25 has been so changed as to contain a larger number of molecules of relatively low weight* than the G-25 produced during the experimental period, and that by reason of this change it is now possible to use resinous material as a sole plasticizer, *its use in making an insulating tape would not constitute infringement, because the plasticizer would still be completely resinous whereas the patent teaches that a liquid as well as a resinous plasticizer must be used."*

After this decision, Plymouth started selling some of its same old tape, unchanged except in thickness (R. 341), under a different trademark, "Slipknot". This product was advertised as "new", though it perhaps should not have been, even though new "to 95 per cent of our prospects" (R. 338). When Minnesota used this advertising as a pretext for disregarding the res judicata effect of *Sears*, Plymouth brought the present action for declaratory and injunctive relief (R. 8-10).

The District Court heard eleven witnesses. Seven were chemists. Much highly complicated technological evidence was adduced; the Joint Consolidated Record Appendix runs to 653 pages. Of this evidence the Court of Appeals said [Pet. 23a]:

"We have laboriously waded through Minnesota's evidence in the record, which for us as non-chemist laymen proved an odyssey fraught with obscurity, confusion and frustration.")

The District Court had before it also numerous samples of various plasticizer materials submitted in evidence (e.g., Exhibits P, Q, and R introduced by Minnesota, R. 292, 204).

On the basis of all this, the District Court made a finding of fact which Minnesota asks this court to declare, after undertaking on its behalf yet another odyssey through its confusing, frustrating, and sophistical evidence, to be clearly erroneous. The District Court found that the tape in suit "*is made in the same way and from the same materials*" and "*is chemically not different from*" the tape adjudicated in *Sears* (Pet. 5a, 8a). It devoted four printed pages (beginning and ending with those just cited) to expanding on evidentiary and credibility considerations supporting its finding.

(a) It was unquestioned that Plymouth was still using only one of either G-25 or G-40, the same-numbered Rohm & Haas resinous plasticizers litigated in *Sears*, and the District Court believed the testimony of the totally independent and highly expert Assistant Director of Research of Rohm & Haas that G-25 and G-40 had remained unchanged since filing of the complaint in *Sears* (R. 88-9, R. 94, Pet. 5a). This testimony was corroborated by that of Plymouth's expert, Mr. DeBell (R. 292, 297).

(b) The District Court believed the testimony of Plymouth's house chemist and production witnesses that there had been "no change in Plymouth's method of manufacture" (Pet. 5a), rejecting Minnesota's argu-

ment that changes in processing had affected the plasticizer.

(c) The District Court found that Mr. DeBell's "tests showed the absence of a liquid plasticizer" (Pet. 6a). It found Minnesota had introduced no direct evidence to the contrary, and found (Pet. 7a) it "significant that all of Minnesota's experts avoided the use of a distillation test which Mr. DeBell testified was a simple, reliable and objective test for determining the presence of liquid plasticizer, the ingredient which the Court of Appeals for the Fourth Circuit held to be an indispensable element. . . ." It found (Pet. 6a) Minnesota's "so-called fractionation tests . . . similar to those upon which Minnesota relied in its motion for rehearing in the *Sears* case and in . . . other cases" involving these parties.

The very fact that the lower molecular weight material had to be separated out by fractionation (because part of a polymeric distribution curve continuum, R. 112, 119, 309, 517), rather than distillation, showed the plasticizer not to be monomeric or liquid, as that issue was adjudicated bindingly on these parties in *Sears* (supra 5), as emphasized in *United States Rubber* (infra 11).

The Court of Appeals disagreed with none of the above findings. It emphasized that the absence of any "liquid" plasticizer, as that term was bindingly adjudicated between these parties in *Sears*, was dispositive, and said (Pet. 24a-25a):

> "We cannot escape the impression that Minnesota has made no attempt to prove the issue in this case but instead is trying either to further litigate the validity of the Fourth Circuit's definition of liquid and resinous plasticizers as those terms are

used in the patent or else to ignore that definition on the spurious ground that the meaning of the terms used in the patent was either not directly in issue or else was not the real basis for decision in the *Sears* case. If there is one thing, however, that the *Sears* case ought to have taught Minnesota it is that the term 'liquid plasticizer' as used in the patent was directly in issue and was held not to mean a resinous type plasticizer even though such a plasticizer might have low-molecular-weight material in it. There is no excuse for further litigating those issues with Plymouth."

The judgment below was neither the second binding on these parties nor the first to adjudicate the very issue of *Sears*' res judicata effect on the Slipknot-branded tapes. *Sears* was only one of many suits Minnesota brought against Plymouth or its customers.

The second judgment binding on these parties was pursuant to *Minnesota Mining & Mfg. Co.* v. *Plymouth Rubber Co.*, 178 F. Supp. 591 (N. D. Ill. 1959). This Chicago action was filed by Minnesota against Plymouth (a Massachusetts company) and a customer the day after Minnesota had sued Sears (a Chicago company) in North Carolina. When Plymouth moved for summary judgment on the ground that *Sears* was res judicata, Minnesota urged (just as it is still doing) that when Plymouth began using the trademark "Slipknot" it changed its plasticizer from that adjudicated in Sears.* Whether *Sears* was res judicata

*Minnesota relied also on an extraordinary affidavit of Mr. Kinney (whose name has from the beginning of this interminable litigation appeared always as of counsel, often as affiant, and on occasion as asserted expert) which baldly attacked the correctness of the decision of the Court of Appeals for the Fourth Circuit, asserting its conclusion of lack of "significant" change in G-25 to be based on hearsay and contrary to the evidence (R. 56). Its

of Slipknot tape, the very product now before this Court, was then actually litigated. "Many affidavits, counter-affidavits, and reply affidavits" were filed (R. 53). In determining this precise question against Minnesota, the Court held that even if a change of the sort asserted by Minnesota had been made, *Sears* was nevertheless res judicata.*

The third judgments binding on these parties were pursuant to *Minnesota Mining & Mfg. Co.* v. *United States Rubber Co.*, 279 F. 2d 409 (4 Cir. 1960; R. 431). Here Minnesota urged that Plymouth's plasticizer had been changed before the complaints in the two customers suits resolved by this decision were filed, well after the *Sears* complaint. Minnesota attempted to show the change by "accepting the statements of Plymouth's affiants that its formulas

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position today is not essentially different, even though semantically more subtle.

*The Court said (R. 57; 178 F. Supp. 591, 595):

> "In fact, the only possibility of change in the plasticizer which the affidavits may be said to reveal is that which may have occurred in late 1957 and early 1958 when concededly the name of the brand of the product was changed and plaintiff's chemist Rathmann's analysis intimates the plasticizer could not be characterized as 'entirely resinous' and contained such 'low molecular weight material' and was 'fluid'.
>
> "The Court is of the opinion from a reading of the two opinions of the Fourth Circuit that any of the asserted and alleged changes which may have been made in Plymouth's product were passed upon by that Court, precluding this Court's review thereof as between the same parties."

A fully alternative ground of decision was that there was no cause of action when the complaint was filed (of which *Sears* was admitted to be res judicata, since the complaints were filed only a day apart), and that a complaint defective in this respect could not be cured through reliance on subsequent events. That these two grounds were alternative and each equally essential to the judgment granting summary judgment is made clear in the District Court's detailed opinion, in which following initial statement of this resolution of the matter (178 F. Supp. 591, 595; R. 57) it was restated in unusual outline form (178 F. Supp. 591, 595-6; R. 58).

have remained the same since the *Sears* case [because the Slipknot branded tapes appeared after even the later complaints] and by showing through analysis that Plymouth's more recent tapes [i.e., the Slipknot branded tapes] contain the liquid element." *Minnesota Mining & Mfg. Co.* v. *United States Rubber Co.*, 279 F. 2d 409, 411 (4 Cir. 1960). Thus, once more, an actually litigated and judgment-determining question became whether Slipknot-branded material infringed. In holding *Sears* res judicata to the contrary, the Court said (279 F. 2d 409, 414-5; R. 441):

> "The molecular weights vary in both kinds of plasticizers but each has its own distinctive form, the liquid plasticizer being monomeric and the resinous plasticizer polymeric in its molecular structure, and it follows that Plymouth's tape did not violate the patent even if it be true, as Rathmann [Minnesota's affiant] suggests, that Plymouth has found a way to make a satisfactory tape by using a resinous plasticizer containing a substantial amount of low-molecular-weight material."

Argument

This case turns, not on the "question presented" by petitioner, but on factual questions dependent on the weighing of complicated chemical evidence including the testimony of numerous expert witnesses. The asserted question would only arise if the District Court's finding of tape sameness were clearly erroneous, as it is not. Even then the asserted question would not be dispositive, in view of the correct concurrent findings of fact by both lower courts that Plymouth's tapes included no "liquid" plasticizer, as was bindingly held essential to infringement in *Sears*. Furthermore, dispositive significance is denied petitioner's asserted question in view of other binding adjudications that Slip-

knot-branded tape itself does not infringe. Further review is not warranted, no question of general interest or importance is involved, and we submit that the time has come when Plymouth should be allowed the fruits of its expensive, long defense of its right of fair competition.

1. The petitioner's "question presented" does not even arise unless the District Court was clearly erroneous in finding that the tape here involved was the same and "chemically not different" from that adjudicated in *Sears*. This finding was not wrong, and there is no other reason justifying Minnesota's request that this Court repeat again the Court of Appeals' "odyssey fraught with obscurity, confusion and frustration" through "Minnesota's evidence in the record" (Pet. 23a).

a. Petitioner's attempt to dispose in a footnote (Pet. 8) of this finding of fact as "vague" and inadequately supported by "subsidiary" findings is without merit. It ignores not only the subsidiary findings set forth in the four pages of the opinion already referred to (Pet. 5a-8a), but also that the finding that the tape was made in the same way from the same materials was itself a primary finding of fact, unlike the ultimate conclusions of the two decisions petitioner cites.*

*In *Kweskin* v. *Finkelstein*, 223 F. 2d 677, 678 (7 Cir. 1955), "The only finding of fact made . . . in addition to the place of residence of each of the parties, was that plaintiff failed to prove the material allegations of the complaint." In *Kelley* v. *Everglades District*, 319 U. S. 415 (1943), the conclusion was that a particular plan of composition under the Bankruptcy Act was "fair, equitable, and for the best interests of the creditors and does not discriminate unfairly" (footnote, p. 421); but this was the issue of law.

In *Kelley*, this Court said (319 U. S. 415, 419):

> "The nature and degree of exactness of the findings required depends on the circumstances of the particular case."

b. In implicitly urging that the District Court finding is clearly erroneous, Minnesota ignores altogether the extensive evidence to the contrary on which the District Court relied (supra 7-8). Instead it argues that (1) the plasticizer in *Sears* included no molecules of molecular weight under 1000, while (2) the plasticizer here contains some (unknown amount, infra 17) of such material, wherefore the plasticizers must be different. The afterthought nature of this "under 1000" argument is apparent from the fact that it did not occur to Minnesota to make it in any of the Chicago, *United States Rubber*, or *Superior* (infra 19) cases, though in all these it contended Slipknot brand infringed. The argument ignores altogether the testimony of the independent expert from Rohm & Haas and the testimony of Plymouth's expert Mr. DeBell that some molecules under 1000 were in the *Sears* plasticizers just as here (R. 111, 119, 120, 309). It ignores the fact that not one of Minnesota's four experts (two of whom were employees) disagreed with this, and one of them admitted, in answer to the question "where you have looked for low molecular weight fraction below 1,000 have you found it?", that he had (R. 208). It ignores the uncontradicted testimony of Minnesota's own employee expert in *Sears* that molecules of weight under 1000 were there involved (respondent's Court of Appeals Brief for Appellee Appendix A-1 through A-15).* All this it seeks to do by giving to cer-

*The material in respondent's Court of Appeals Appendix A is reprinted from the record in *Sears*, which was filed in this Court on petition for *certiorari*, October Term, 1957, No. 673, and so is properly subject to judicial notice. *National Fire Ins. Co.* v. *Thompson*, 281 U. S. 331, 336 (1930).

The reference to 1000 as a floor first came in the testimony of one of Minnesota's chemists, Tierney (A-2). When he first used it even that way, for G-25, he was speaking of (A-4) "the weight average".

tain answers to requests for admissions its own hyper-technical and truth-defeating interpretation. However, the practical concern in formulating plasticizers is for significant quantities by weight (supra 13, footnote); and read in this context the answers give Minnesota no comfort. Even if the answers be simply ambiguous in this respect, the record clarifies them. Certainly Minnesota's interpretation, not accepted by the lower courts, should not be allowed to defeat truth here, where Minnesota did not object to evidence to the contrary at the trial (and indeed both offered such evidence, R. 31, and elicited it on cross-examination, eg. R. 309)*, and where its own chemists knew the untruth of the asserted interpretation.** (Minnesota's sugges-

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and remarked that this was "specifically more important [than number of molecules] where any formulation that requires weight of material, is specified. . . ." He went on to note that his low (bottom 33%) fraction of G-40 had from "1 to 20 links" (with number average of 2500 and weight average of 5300) and his low fraction of G-25 from 1 to 36 links (A-5). When asked if this was not inconsistent with his mention of 1000 (A-7) he replied (A-8) that in mention of a range from 1000 up he had been giving "the approximate range" (which might of course be so given with equal truth here). He went on (A-8): "[T]here may very well have been a small portion that would be from five hundred . . ." He repeated and amplified this later (A-9). DeBell, although his early testimony could initially have been construed otherwise (A-11), made it plain that his testimony on individual molecules was based not on experiment but solely on dividing the 1000 he understood Tierney to have used as a floor by the weight of the building blocks (A-14).

(The definitions of number average and weight average molecular weights were through mistake in error in the brief to which Appendix A is attached; this was subsequently corrected below.)

*Judicial admissions should be dealt with in a manner promoting substantial justice. Wigmore, "A Treatise on the Anglo-American System of Evidence on Trials at Common Law", v. 9, pp. 587-8 (3 Ed. 1940). Even pleadings should be treated as amended to conform to evidence admitted without objection on questions thus tried with implied consent. F. R. Civ. P. 15(b).

**_Russell-Miller Milling Co._ v. _Todd_, 198 F. 2d 166, 169 (5 Cir. 1952), in which one party obtained from another a stipulation inconsistent with evidence known to it.

tion that *Sears* turned on a 1000 dividing line flies in the face of the opinions as well as the record there. The figure was only mentioned in connection with a "for example" mention of one of the two resinous plasticizers there in issue [supra 6]. The figure 600 might with greater force be urged, for at least it was used in connection with a class of plasticizers. The real truth is that the decision did not turn on any specific molecular weight dividing line.)

c. Minnesota's argument that the plasticizers are different because the low fraction here was assertedly "migrating" and the low fraction there not is similarly without merit. When the continuum of a resinous plasticizer is cut into two fractions, the characteristics of the lower fraction naturally turn on how big the fraction is.* This is illustrated by Dr. Mark's work relied on by Minnesota: When the cut was the lowest 1.3%, number average molecular weight was 252; when the cut was the lowest 10.35%, the number average was 600. These data were from G-40 tapes (R. 249-252). The fraction of G-40 taken in *Sears* was 33% (R. 30). Mr. DeBell testified (R. 313):

> "I don't think we can compare, say, a 20 per cent cut . . . with some other cut, whatever it is, that is not in this vicinity.
>
> * * *
>
> *"There are low cuts and low cuts."*

2. Even if (contrary to fact) the District Court's finding of fact of tape sameness was clearly erroneous, the

*Minnesota urges that "its proof is wholly unlike that before the Fourth Circuit" (Pet. 6). It could have relied on smaller low fractions in *Sears*, had it chosen to do so.

"question presented" by petitioner would not be dispositive because of the concurrent findings of fact by the lower courts that Plymouth used no plasticizer that was "liquid" in the sense of the patent, as adjudicated between these parties in *Sears*. As the Court of Appeals said (Pet. 14a) in addition to what has already been quoted (supra 8-9):

> "Once ferreted out the determinative issue . . . becomes relatively simple. But to drive the quarry out of its burrow we must analyse the patent and review this and other litigation between the parties over it."

This freedom from "liquid" plasticizer collaterally estops Minnesota's present assertion of infringement even assuming (contrary to fact) the sort of plasticizer change petitioner urges. Minnesota in its conduct since *Sears* and in its very statement here of the alleged "question presented" seems unwilling to recognize that total identity of evidence presented, even to its form, is not a prerequisite of collateral estoppel. Its assertion that the decision below is "in apparent conflict" with *Cromwell v. County of Sac*, 94 U. S. 351 (1876) and other collateral estoppel decisions of this Court is without merit, a compound of petitioner's misconception of what collateral estoppel is and its refusal to accept findings of fact made below.

3. The asserted "question presented" is not dispositive because additionally of the judgments entered pursuant to each of the Chicago (supra 9) and *United States Rubber* (supra 10) decisions. Although Slipknot-branded tape was not itself within the complaints, that this precise tape did not infringe was actually litigated in each, and the determination that it did not was essential to the judgment in each ("Restatement, Judgments", § 68 and *Comment n* thereto, pp. 293, 307). Minnesota's attempt below to ignore them because on summary judgment was without merit, *Morris v. Jones*, 329 U. S. 545, 550-1 (1947). So too was

its argument that these grounds of res judicata, specifically emphasized at least as early as Plymouth's pre-trial brief, and within the general pleading allegations of res judicata, were not properly before the courts.

4. Both below and here Minnesota has closed its eyes to the manner in which it narrowed its original claims to avoid rejection. From a claim to a liquid plasticizer generally as one component of the two-component plasticizer mixture, the claims were narrowed to call for a *phthalyl ester* type of liquid plasticizer; there is not even any contention that Plymouth has used a phthalyl ester. At the same time, from a claim in which the liquid part of the plasticizer had no bottom limit, amendment was made to make 8 parts per 100 parts of plastic the floor. File wrapper estoppel would prevent infringement even if the judgment were the first as between these parties.* *Minnesota Mining & Mfg. Co. v. Permacel-LePage's Inc.*, ——F. Supp. ——, 139 USPQ 41, 43 (N. D. Ill. 1963). The weights Minnesota used in the present action were of fractions identified in terms of "number averages", although its own witness had conceded

*When broader claims have been surrendered and narrower accepted to overcome a Patent Office rejection, recapture of the broader claims through assertion of the doctrine of equivalents is sternly prohibited. *Exhibit Supply Co. v. Ace Corp.*, 315 U. S. 126 (1942). This is so even assuming (for present purposes only) that the Patent Office was in error. *Exhibit Supply*, 315 U. S. 126, 137. It is so too whether the rejection overcome by the cancellation or amendment was on the ground of prior art, or of indefiniteness (of which functionality is an aspect), *Parke, Davis & Co. v. American Cyanamid Co.*, 207 F. 2d 571, 574 (6 Cir. 1953), or of both, as here. File wrapper estoppel cannot be avoided by a purported "reservation" (like petitioner's, R. 561-2) of right to recapture in court on an equivalents theory what was surrendered to induce grant of the patent. *Johnson Furnace & Engineering Co. v. Western Furnace Co.*, 178 Fed. 819, 824 (8 Cir. 1910); *Thomas v. Rocker Spring Co.*, 77 Fed. 420, 431 (6 Cir. 1896; Judge [later Mr. Justice] Taft), cert. den'd 168 U. S. 709; *Parke, Davis & Co. v. American Cyanamid Co.*, 207 F. 2d 571, 574 (6 Cir. 1953).

that when, as here, parts by weight is the question, the important average is the weighted "weight average" [supra 13, footnote]; and his testimony there as well as Mr. DeBell's here [R. 287] indicates that weight average tends to run about twice number average. Petitioner, further, does not deny that its cuts of "number average" below 1000 include molecules above 1000, inconsistently with its own artificially contrived "under 1000" theory, the weight of molecules actually under 1000 being completely unproved.)

5. As an alternative ground for holding that Plymouth did not infringe, it was held in *Sears* that if the "dubious" (R. 425) new plasticizer definition in the claims new in the reissue be construed (as Minnesota contended they should be, R. 419) as not requiring any "liquid" plasticizer, they were void.* That Plymouth has not infringed these claims is res judicata for this reason as well. (Plymouth's invalidity defenses, including this one, were improperly struck by Judge McCarthy, who did not try the case, but whose ruling Judge Caffrey did not think it seemly to review [Pet. 2a]. Plymouth's appeal, which was in any event unnecessary to bring up error in this ruling as an alternative ground supporting the judgment in its favor [e.g., *G. Leblanc Corporation* v. *H. & A. Selmer, Inc.*, 310 F. 2d 449, 454-5 (7 Cir. 1962) cert. den'd 373 U. S. 910] was dismissed as moot [Pet. 20a, 25a]. These defenses were struck on Minnesota's extraordinary argument that the old District Court

*A claim added by reissue which seeks to make non-essential what the original application taught essential is invalid. *U. S. Chemicals Co.* v. *Carbide Corp.*, 315 U. S. 668 (1942).

Reissue is also improper, and claims thus obtained invalid, unless omitted originally by mistake rather than in exercise of strategic judgment to obtain grant of the original patent. Cancellation of a broader claim, as here, shows lack of mistake in the sense prerequisite to a proper reissue. *Dobson* v. *Lees*, 137 U. S. 258, 265-6 (1890). That the broader original claim canceled to accept a narrower one is made even broader by reissue application does not justify recapture within the latter of what was intentionally forgone.

judgment in *Sears*, although reversed and vacated, adjudicated in the loser's favor something that could not have been essential to the only final judgment left outstanding [R. 62].)

6. The extent to which Minnesota has abused its access to our nation's Courts is simply shocking. Petitioner was urging that "G-25 had changed significantly over the years" in petitioning in this Court for certiorari in *Sears* (Oct. Term 1957, No. 673, p. 10). It still is. Five lengthy decisions of Courts of Appeals alone have been necessitated, three since then; in addition to those already mentioned was one in another customer suit, *Minnesota Min. & Mfg. Co.* v. *Superior Insulating Tape Co.*, 284 F. 2d 478, 482 (8 Cir. 1960), in which the Court commented:

> "There is reason to believe that there should be some limit to the number of times the courts should be required to consider claims involving identical issues."

The District Court in the present action adopted this language from Plymouth's brief as "aptly" descriptive of this "litany of litigation" (Pet. 2a, 9a):

> "The customer cases constitute a story of proliferation of litigation on a single issue, abuse of judicial process, persistent trying of identical issues in different courts, and oppression and harassment unequaled in our experience. We know of nothing quite like it in the reported cases."

The Courts below held that in view of this history of litigation, further suits of this sort should be enjoined (Pet. 11a, 25a). We submit that it is indeed time Plymouth be allowed to enjoy peacefully the fruits of its successful defense.

Conclusion

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

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